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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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MM92/0505

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EXAMINER
DUIER

ART UNIT 2871 PAPER NUMBER

DATE MAILED: 05/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/241,989

Applicant(s)
Suzuki et al

Examiner
James Dudek

Group Art Unit
2871



☒ Responsive to communication(s) filed on Nov 1, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 and 11-42 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7 is/are allowed.

☒ Claim(s) 8, 9, and 11-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11/1/99

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Reissue Applications

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

corrected
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The pending claims deleted the "arranged side-by-side" limitation. By doing so, Applicants are claiming subject matter which was not disclosed in the specification as originally filed, since all the embodiments, examples and figures disclose the prisms arranged in a side-by-side manner. The new matter being the prisms arranged in something other than a side-by-side manner. Applicant has not disclosed in the originally filed specification "a variation in pitches between the tops of adjacent isosceles triangle prisms." Again this limitation constitutes new matter. *corrected*

Recapture Rejection - 35 USC § 251

4. The following is a quotation from the MPEP 1412.02.

The recapture rule bars the patentee from acquiring, through reissue claims that are of the *same or broader scope* than those claims that were canceled from the original application. (See MPEP 1412.02)

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5. Claims 8-9 and 11-42 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

Claim 8 claims "An optical film of light transparent material including a first surface having an optically rough structure for diffuse-transmitting incident light and a second surface having a wave structure including a plurality of isosceles triangle prisms arranged side-by-side substantially throughout said second surface, the prisms having smooth surfaces for refracting said light diffuse-transmitted from said first surface and directionally distributing said diffuse-transmitted light through said second surface for increasing illumination within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction." Claim 9 adds to claim 8 the top angle of the isosceles triangle prisms is in a range of about 90 degrees to about 120 degrees.

Claims 8 and 9 limitations are found in originally filed claims 1-2. Claims 1-2 claim "An optical film of transparent material, comprising: a first surface having a wave structure including a plurality of isosceles triangle prisms arranged side-by-side, and a second surface having an optically rough structure for performing diffuse transmission." Claim 2 adds a top angle of said isosceles triangle prisms is in the range of 90 degrees to 120 degrees.

Prosecution history of claims 1-2 follows. The originally filed claims 1-2 were rejected in paper number 6 of patented application. The applicant then canceled claim 2 and amended claim 1 by adding a range of 95 degrees to 120 degrees (paper number 8). The applicant later added to claim 1 the prisms having smooth surfaces (paper number 13). The Examiner then finally rejected claim 1 which included the smooth prism and range of 95-120. After an interview with the Applicant's representative, the Examiner indicated that the claims as amended appear to be allowable (paper number 15) in the amendment the applicant canceled claims 1, 3, 6, 9, 13 and 15-21. The amended claims included a range of 95 degrees to 120 degrees and the applicant argued the criticality of this range (which the specification disclosure supports) in paper number

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16. The prosecution history clearly shows claims that were canceled or amended which are now sought by the Reissue application.

Furthermore, the limitation for increasing illumination within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction is disclosed in the specification as being inherent for a prism top angle of 90 degrees to 120 degrees. Although the critical angle of 95 degrees to 120 degrees produces far better results for the claimed viewing angle, the 90 degrees to 120 degrees can be found in the specification and figures 6 and 7.

Claims 11-12 are also rejected because applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejections.

Regarding claims 13-19 and 24-27, they have similar prosecution history. Claim 13 limitations are found in originally filed non-amended claim 5 which was then amended in paper number 13 and again in paper number 16 which was allowed. Claim 24 limitations are also found in originally filed non-amended claim 5. Claims 9, 14, 18 and 25 limitations are found in originally filed non-amended claim 2. 11's limitations are found in originally filed non-amended claim 7. Claims 16 and 17 limitations are found in originally filed non-amended claim 10.

Again, claims 14-19 and 25-27 are also rejected because applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejections.

Regarding claims 20-23, claim 20 claims an optical film comprising a diffusing means for diffuse transmitting light illuminated proximal to the back portion of the display and refracting means including a plurality of isosceles triangle prisms arranged side-by-side for directionally distribution the diffuse-transmitted light toward the front portion of the display for increasing luminance of light within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction of the front portion of the display. These limitation are found in original claims 5-6. The "...increasing luminance of light within a viewing angle of about

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35 degrees in the vertical direction and about 55 degrees in the horizontal direction of the front portion of the display” limitation is inherent. Applicant specification discloses at column 5 that the angle of the prisms is one factor that produces the desired result of increasing luminance of light within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction. Thus, a claim claiming an optical film of transparent material, comprising: a first surface having a wave structure including a plurality of isosceles triangle prisms arranged side-by-side, and a second surface having an optically rough structure for performing diffuse transmission, wherein a top angle of said isosceles triangle prisms is in the range of 90 degrees to 120 degrees would inherently increase luminance of light within a viewing angle of about 35 degrees in the vertical direction and about 55 degrees in the horizontal direction.

Accordingly, claims 8-9 and 11-42 are not used to solve an error within the meaning of 35 U.S.C. 251.

Response to Arguments

6. Applicant's arguments filed 11/1/99 have been fully considered but they are not persuasive.

Applicants' argument that the recapture rule does not bar the subject matter of claims 8 and 9 is not persuasive. Applicant cites MPEP 1412.02 “If the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.” as support for the argument. The reissue claim is broader in an aspect related to a rejection.

The Examiner wrote in the interview summary (paper no. 15) “The claims as amended appear allowable over the prior art.” Then in paper #16 Applicants amended the claims by deleting the 90°-120° range. Furthermore, in Applicant argued in paper no. 16 that “The applicant's have found that the angled top surfaces of the film 8 reflect the light into the desired viewing angles best when the angle between these flat surfaces is between 95 to 120 degrees. Further, improvements in the viewing light occur when the tops of the prisms are spaced at regular intervals not exceeding 160 m to prevent visible interference fringes and are aligned with a

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polarizing axis of the polarizer to decrease light loss.” That part of the prosecution history clearly provides evidence supporting the recapture rule.

Applicant also argues, on page 6, that “By the time of this rejection (paper no. 14), the top angle feature, whether 90 degrees to 120 degrees or 95 degrees to 120 degrees, was not an issue.” The Examiner disagrees with this argument. Again the Applicants states many times in the prosecution history that a correlation exists between the viewing angle of 35 degrees and 55 degrees and the prism having a top angle of 95 degrees to 120 degrees. Most importantly, Applicants surrendered the top angle range of 90 degrees to 120 degrees in paper no. 16., since Applicants argued the criticality of the viewing angles and correlated the viewing angles to the top prism angle of 95 degrees to 120 degrees to the viewing angles and then proceeded to delete all limitations having 90 degree to 120 degree range.

Allowable Subject Matter

7. Claims 1-7 are allowed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Application/Control Number: 09241989

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Any inquiry concerning this communication should be directed to James Dudek at telephone number (703) 308-4093.

May 2, 2000

A handwritten signature in black ink, appearing to read 'James A. Dudek', with a stylized, looping flourish at the end.

James A. Dudek
Primary Examiner
Technology Center 2800